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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,556	04/09/1999	J. PETER KLEIN	44033-080	7605

20277 7590 09/16/2002  
MCDERMOTT WILL & EMERY  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER

RAYMOND, RICHARD L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/16/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/288,556

Applicant(s)

KLEIN ET AL.

Examin r

Richard L. Raymond

Art Unit

1624

-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2002 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

## DETAILED ACTION

### *Election/Restrictions*

1. Pursuant to the requirement for election of species, applicants' have elected the compound of formula (I) where X is N(R<sub>3</sub>), Y is N, Z is C(R<sub>3</sub>), R<sub>1</sub> is C<sub>(5-9)</sub> hydroxyalkyl and R<sub>2</sub> is CH<sub>3</sub>. Claims 1-21 are readable thereon.

### *Improper Markush Rejection*

2. Claims 1-8 and 10-21 are rejected as being improper Markush claims in the definitions of the X, Y, Z and R<sub>1</sub> variables. With respect to the X, Y and Z variables, the resulting total compounds lack a common heterocyclic ring core. With respect to the R<sub>1</sub> variable, the resulting total compounds containing diverse substituents are structurally diverse and patentable distinct one from the others. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Diverse fields of search in the U.S classification system and in STN/CAS are also involved. Limitation of the claims to compounds where X is N, Y is N, Z is C(R<sub>3</sub>) and R<sub>1</sub> is C<sub>(5-9)</sub> hydroxyalkyl, encompassing the elected species, will overcome this rejection.
3. The claims have been searched and examined to the extent that they read on the grouped invention above.

***Claim Rejections - 35 USC § 112***

4. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (1) In claim 1, the proviso clause refers to R<sub>1</sub> not being an w-1 alcohol substituted C<sub>(1-8)</sub> alkyl group, however, R<sub>1</sub> is defined as being C<sub>(5-9)</sub> hydroxyalkyl groups. See page 7, lines 10 and 11 of the specification where alcohols of C<sub>5-8</sub> are provisoed. (2) In claim 1, lines 1 and 2, the reference to enantiomers, tautomers, salts and solvates should preferably be recited at the end of the claim and not contain the language "including". (3) Claim 9 which refers to the compounds in Table 1 of the specification is indefinite because claims should be complete in themselves. Correction and/or clarification of the above are requested.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinze et al., of record, the present application being a CPA. Specifically, the proviso in claim 1 excludes R<sub>1</sub> being an (w-1) alcohol substituted C<sub>(1-8)</sub> alkyl group when R<sub>3</sub> is H or C<sub>1-3</sub> alkyl. However, the present R<sub>1</sub> containing compounds include the simple alkyl homologs and position isomers of these prior art compounds. Further, when the present compounds when R<sub>3</sub> is 4-8 alkyl are simple

homologs of the provisoed compounds. One would be motivated to prepare simple homologs and/or isomer of the reference compounds with the reasonable expectation of obtaining additional compounds for the uses in of the reference compounds. In the absence of a showing of unexpected properties, no patentable significance is seen in the present selection.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### *Conclusion*

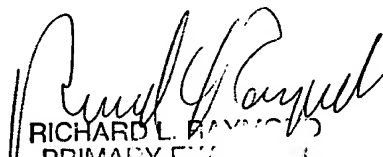
8. Due to the number of applicants' related applications and patents, an interview is suggested to clarify the subject matter intended to be claimed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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September 13, 2002

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624